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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,228	06/01/2001	Jean Brossard	402078	3769

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EXAMINER
WHITE, CARMEN D

ART UNIT	PAPER NUMBER
3714	5

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/872,228	Applicant(s) BROSSARD, JEAN	
	Examiner Carmen D. White	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-27,32-58 and 63-71* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-27,32-58 and 63-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Objections

Claim 64 is objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim depends from itself.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-8 and 17-18 contain the trademark/trade name Elvis Presley™ . Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a well-known celebrity (Elvis Presley™) and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 9, 19, 23, 32-33, 37-40, 45, 49-50 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by ***Walker*** et al (6,234,896).

Regarding claims 1, 19, 23, 32, 49 and 53, Walker teaches a gaming device that comprises a player input wherein a round of play is initiated; game output determination wherein an outcome of said round of play includes at least first and second outcome types; an output which indicates a monetary prize amount in response to a winning outcome of the first outcome type; an audiovisual display which in response to a winning outcome of a second outcome type (col. 1, lines 65-67 through col. 2,lines 1-2) that is distinct from the first outcome type, displays an entertainment event comprising an audiovisual clip of a performance in accordance with a first theme of said gaming device as an award, wherein the first theme is predetermined (abstract; col. 3, lines 1-5).

Regarding claims 2, 33, 50, Walker teaches all the limitations of the claims as discussed above. Walker further teaches a distinct audiovisual display (col. 3,lines 46-53).

Regarding claims 3-4, 9, 37-40, 45, Walker teaches all the limitations of the claims as discussed above. Walker further teaches a first theme that is based on one or more celebrities {movie, music video, soap opera, etc.} (col. 3, lines 1-5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-8, 10-18, 20, 34-36, 41-44, 46, 51-52 and 63-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Walker*** et al (6,234,896).

Regarding claims 15, 44, 63, 66, 69, Walker teaches all the limitations of the claims as discussed above. While Walker teaches the selection of a video clip, Walker lacks teaching that the clips are picked at random. Walker is functionally capable of providing random video selection via the network server. This is merely a matter of software programming. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Walker to make the results more unpredictable and thereby increase enthusiasm for playing the game.

Regarding claims 64, 67, 70, Walker teaches all the limitations of the claims as discussed above. Walker is silent regarding the feature of the selection of the audio/video clip by a moving member, which stops randomly on the clip. However, the examiner takes notice that it is well known in the art to provide a rotating dial that randomly points to a prize (e.g. Wheel of Fortune™). It would have been obvious to a

person of ordinary skill in the art at the time of the invention to include this feature in Walker as a means of selecting the prize clip to increase the player's enthusiasm for the outcome. This would increase player participation to the game by making it more exciting.

Regarding claims 10, 16, 35, 65, 68, 71,51, Walker teaches all the limitations of the claims as discussed above. Walker teaches the selection of an audio/video clip for the player via a server based on a player's identification parameters (col. 3,lines 33-36; col. 5,lines 59-64). However, Walker lacks teaching player selection of the clip. It would have been obvious to a person of ordinary skill in the art at the time of the invention to enhance Walker by including selection by the player of the video clip to give the player increased control over the gaming outcome. This would provide an added incentive for the player to play the game.

Regarding claims 6-8, 17-18, Walker teaches all the limitations of the claims as discussed above. Walker further teaches a video clip that is a music video or movie. These types of video clips are well known for having singing or acting celebrities. However, Walker does not teach the particular figure of Elvis Presley (this feature is indefinite- see above). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include any celebrity, such as Elvis, to motivate a fan to play the game. This would increase sales to the gaming establishment.

Regarding claims 11, 34, 36, 52, Walker teaches all the limitations of the claims as discussed above. Walker is silent regarding the explicit teaching of the feature of the

video being associated with a bonus award. However, the examiner takes official notice that bonus awards are well known in the art. They provide increased incentive for players to continue wagering on a gaming machine. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to make the payout parameter a bonus outcome in Walker for the playing of the audio/video clip.

Regarding claims 12-14, 41-43, 46, Walker teaches all the limitations of the claims as discussed above. Walker is silent regarding the display of indicia, further highlighted indicia with differing levels of illumination. The examiner takes notice that it is well known to highlight indicia by illumination in slot machines. It would have been obvious to a person of ordinary skill in the art to include this feature in Walker to draw attention to the game display; thereby increasing player interest and promoting game play.

Regarding claim 20, Walker teaches all the limitations of the claim as discussed above. Walker further teaches a slot machine with simulated machine reels and a video display for indicating cards or other wagering game indicia (col. 2,lines 61-67). However, Walker is silent regarding physical [i.e. mechanical] slot reels. The examiner takes notice that this is well known in the art to have mechanical slots. This predates video slots. It would have been obvious to a person of ordinary skill in the art to include mechanical reels in Walker to ensure game play can continue in the event of software/network problems. This would ensure that game sales do not diminish due to inoperability of the device.

Claims 21-22, 24-27, 47-48, 54-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Walker*** et al (6,234,896) in view of ***Acres*** et al (5,752,882).

Regarding claims 21-22, 24-27, 47-48, 54-58, Walker teaches all the limitations of the claim as discussed above. Walker lacks teaching the feature of a progressive prize jackpot. Acres teaches a progressive prize (abstract and Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the progressive prize of Acres in Walker to increase the player's winnings; thereby, making the player more motivated to continue playing the slot machine.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbesr for the organization where this application or proceeding is assigned are 703-746-3244 (unofficial communications) and 703-305-3579 (official communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

cdw

S. THOMAS HUGHES
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